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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,790	11/12/2003	Allen W. Van Noy	ADI-098	7808
51414	7590	03/01/2006	EXAMINER	
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			KAVANAUGH, JOHN T	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/712,790	Applicant(s) VAN NOY ET AL.	
	Examiner Ted Kavanaugh	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14, 18-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 15-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Nov. 7, 2005.

Claim Rejections - 35 USC § 112

2. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 5 define the guide surface with respect to the movement of the shoe relative to the ground and the passing airflow and therefore are indefinite inasmuch as the angle with respect to the ground is not known and the direction of the air flow is not known.

Applicant's arguments:

Applicant argues that the angle is disclosed in the figures and in the specification.

In response, the question is not with regard to if the angle is disclosed, it is whether the claim is definite. The direction of the air flow is an unknown variable. The air flow, with respect to the shoe, could come in many different directions and therefore the scope of the claim is not clear.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-14,18-20,22-28,30-32,34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by US 1717183 (Brenner).

Benner teaches a shoe having a ventilation system (the shoe will inherently provide ventilation inasmuch as it has a plurality of openings in the shoe upper) as claimed including at least one opening in the upper, a beam (10), and a plurality of parallel guiding surface/ vanes (11) extending over the openings forming channels between the vanes, the guiding surface appear to be in the angles as claimed. The openings between the vanes (11) allow for air to enter and exit. The vanes (11)

inherently function as a guiding surface. The vanes as shown in figure 3 have a rectangular cross-section and therefore have edges wherein any of the top edges can be a leading edge which will inherently redirect the airflow into the opening.

Applicant arguments:

Applicant argues that Brenner does not teach or suggest guiding surface or vanes bridging an openings and having a leading edge adapted to redirect airflow into the opening.

To the contrary, as noted above the members (11) have structure of vanes which bridge across the openings in the shoe and the members have edges which inherently will re-direct airflow. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted

above, it would clearly seem to be inherently capable of performing the functions as claimed.

Regarding claim 22, applicant argues that Brenner doesn't teach both an outlet and an inlet with a ventilation channel in fluid communication with the inlet.

To the contrary, the structure of Brenner has a plurality of openings formed by the vanes and channels, like applicants, are formed between the vanes. Any of these openings can be an inlet or an outlet depending on direction of the air flow. The air can flow through a channel on the medial side of the shoe and out an channel on the lateral side of the shoe.

5. Claims 1-14,18-20,22-28,30-32,34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2082309 (Turiansky).

Turiansky teaches a shoe having a ventilation system as claimed including at least one opening in the upper, a beam (cross strips 2), and a plurality of parallel guiding surface/ vanes (outer strips 1) bridging the openings, the guiding surface appear to be in the angles as claimed. The openings between the vanes (1) allow for air to enter and exit. The vanes (1) inherently function as a guiding surface and help to direct air into the openings. The vanes have a rectangular cross-section and therefore have edges wherein any of the top edges can be a leading edge which will inherently redirect the airflow into the opening.

Applicant's arguments:

Applicant's arguments for Turiansky are basically the same as they are for Brenner above inasmuch as Turiansky and Brenner have similar structure.

6. Claims 20,22-28,30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 9208875.9 (Hsing).

Hsing teaches a shoe having a ventilation system as claimed including at least one opening in the upper and a plurality of parallel guiding surface/ vanes (see figure 1 and page 6 of the translation) extending over the openings, the guiding surface appear to be in the angles as claimed. The openings allow for air to enter and exit.

Applicant's arguments:

The rejection with regard to claims 1,32 and claims that depend therefrom have been withdrawn in view of the amendment.

Regarding claim 22, applicant argues that Hsing doesn't teach both an outlet and an inlet with a ventilation channel in fluid communication with the inlet.

To the contrary, the structure of Hsing has a plurality of openings formed by the vanes are formed between the vanes. Any of these openings can be an inlet or an outlet depending on direction of the air flow. The air can flow through a channel on the medial side of the shoe and out an channel on the lateral side of the shoe.

All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an

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anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

7. Claims 22-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6871420 (Shikahashvili).

Shikahashvili teaches a shoe having structure as claimed including at least one opening in the upper and at least one in the sole, and a plurality of parallel guiding surface/ vanes (fins 3) extending over the openings, the guiding surface appear to be in the angles as claimed. The vanes (1) inherently function as a guiding surface and help to direct air into the openings into a lower portion of the inlet and therefore inherently is a ventilation system. Regarding claim 33, the vane (fin 3) is triangular shaped, see figure 2 and 4C.

Applicant's arguments:

The rejection with regard to claims 1,32 and claims that depend therefrom have been withdrawn in view of the amendment.

Applicant argues that the shoe structure of Shikahashvili is to provide promotional force for swimming and the other ones are to permit water and sand to drain from the shoe.

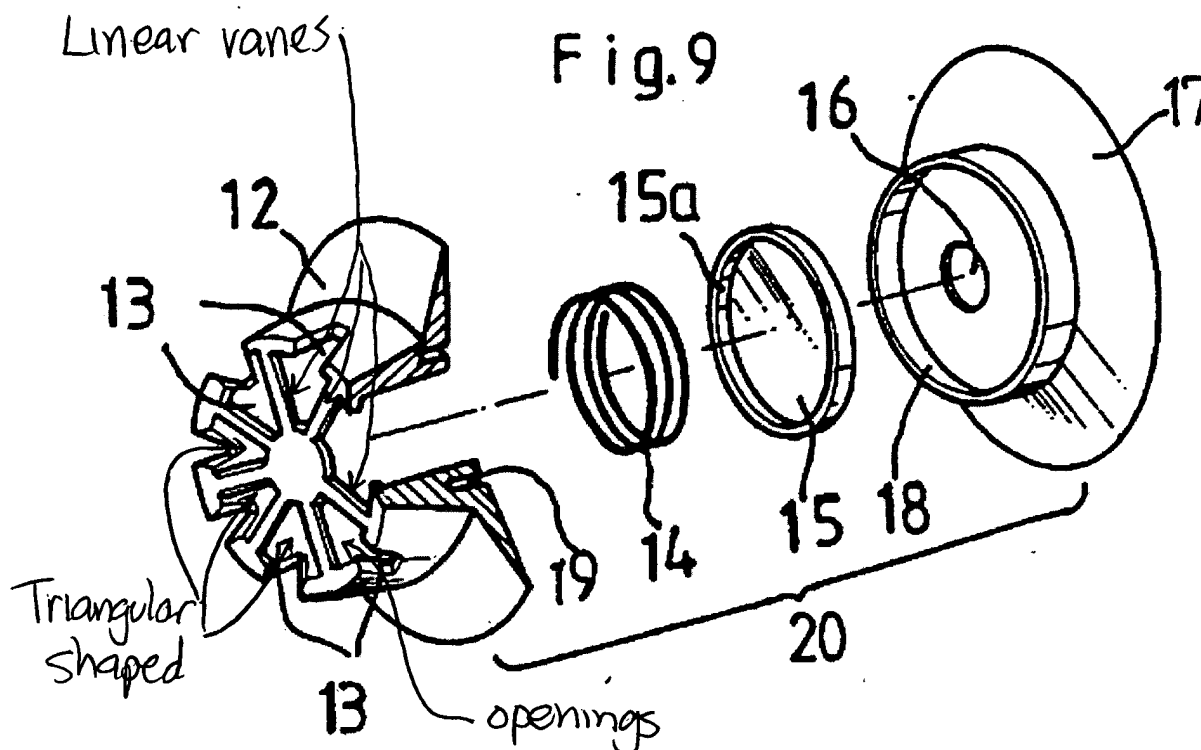
In response, all of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

8. Claims 32,33 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5086572 (Lee).

Lee teaches a shoe having a ventilation system with structure as claimed including an upper with at least one opening (see figure 9 below), a substantially liner

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vane bridging the openings and the vane is substantially triangularly shaped. The vanes re-direct the airflow and have edges that encounter the air flow and therefore inherently have a leading edge as claimed.



Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the following: Shikhashvili '420 or Hsing or Turiansky '309 or Brenner '456.

To the extent that the angles fall out of the range as claimed, it would be an obvious design choice to orientate the guiding surfaces with the angles as claimed inasmuch as a plurality of different angles appear to be suitable and inasmuch as applicant doesn't teach that this provide any new or unexpected results.

11. Claims 21 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references Hsing or Turiansky '309 or Brenner '456) as applied to claims 20 and 28 above, and further in view of US 1974456 (Goldzweig).

Goldzweig teaches provide a shoe sole with centrally located outlets (8). It would have been obvious to provide the shoe as taught above with the sole having centrally located outlets, as taught by Goldzweig, to provide further ventilation.

Response to Arguments

12. Applicant's arguments filed Feb. 10th, 2006 have been fully considered but they are not persuasive.

Applicant's arguments have been addressed in the body of the claims above.

13. Applicant's arguments with respect to claim 33 has been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”


-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to **Ted Kavanaugh whose telephone number is (571) 272-4556**. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
February 27, 2006